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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/835,855 | 04/17/2001 | Shinichi Baba | 04900.00002 | 4194 |
| 22907 | 7590 | 06/08/2004 | EXAMINER | |
| BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001 | | | FERGUSON, KEITH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2683 | 8 |
| DATE MAILED: 06/08/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-------------------|--------------|--|
| Application No. | Applicant(s) | |
| 09/835,855 | BABA ET AL. | |
| Examiner | Art Unit | |
| Keith T. Ferguson | 2683 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 4,5,7 and 8 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-3 and 6 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 8.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Abbasi et al..

The claimed invention reads on Abbasi et al. as follows:

Regarding claim 1, Abbasi et al. discloses a system (fig. 1) for setting up base stations in relations to existing base stations (col. 1 lines 40-53 and col. 2 lines 8-14 and col. 4 lines 11-59), comprising: a first base station having a receiver (transceiver) (col. 2 lines 15-45), a processor (controller) (col. 2 lines 15-45) and a transmitter (transceiver) (col. 2 lines 15-45), wherein said receiver receives signals (signal strengths) from existing base stations (base stations or IRP) (col. 4 lines 12-31), said processor processes adds said existing base stations to a list of base stations (col. 4 lines 36-59), and said transmitter transmits said list to other base stations (base stations or neighboring stations or IRP) (col. 4

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lines 36-59). Abbasi et al. further discloses the receiving base stations or IRPs stores the list within their memory (col. 4 lines 55-60).

Regarding claim 2, Abbasi et al. discloses said list includes candidates base stations and always handoff base stations (col. 2 lines 10-15).

Regarding claim 6, Abbasi et al. discloses a method (fig. 5) for setting up a base station (col. 4 lines 11-59) comprising the steps of: determining neighboring base stations (col. 4 lines 11-59); monitoring signals associated with said base stations (col. 4 lines 11-59); determining how said signals compare with a signal generated by said base station (col. 4 lines 11-59); ordering said base stations into a list (col. 4 lines 11-59); and, transmitting said list to said base stations (col. 4 lines 11-59).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abbasi et al. in view of Dolan.

Regarding claim 3, Abbasi et al. discloses a system as discussed supra in claim 1 above. Abbasi et al. differs from claim 3 of the present invention in that it do not disclose other base stations approve or disapprove of said list from said base station. Dolan teaches a semi handoff candidates approve or disapprove of a list of semi handoff candidates for performing handoff (col. 9 lines 34-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abbasi et al. with other base stations approve or disapprove of said list from said base station in order for the system to update the other base stations or IRPs memory with the list of neighboring base stations that are qualified for hand off, as taught by Dolan.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grandhi et al. (U.S. Patent 6,125,280) discloses a new cell measures signal

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strengths of different channel used by existing cells, the new cell generates a list of candidate channels corresponding to the channels with the greatest signals strengths (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Keith Ferguson

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May 26, 2004

Kelt J